

## **REMARKS**

### **A. Amendment To The Drawings**

In the Amendment filed on August 11, 2203, Applicant attached as "Fig. 10" and "Fig. 10A" and amended the specification accordingly in response to the following drawing objection:

The Examiner has required that a proposed drawing be submitted to show "the cap has a spout that projects from one side thereof upwardly, the spout is formed integrally with the cap and includes a front and rear walls that converge to an outwardly protruding tip of the spout" and "a valve located adjacent to or incorporated into the spout wherein the valve substantially prevents a liquid from leaking out of the spout."

In addition, the August 11, 2003 Amendment detailed the reasons that the addition of the figures added no new matter added:

For example, at page 2, the specification discloses "a valve located adjacent to or incorporated into the spout wherein the valve substantially prevents a liquid from leaking out of the spout." In another example, page 13 of the specification discloses "a valve on the under side of the lid may substantially prevent liquid from leaking out of the spout. Examples of valves that may be used with the present invention include, but are not limited to, the valves disclosed in United States Patent Nos. 5,079,013, 5,542,670, RE37,016, and 6,050,445, which are incorporated by reference herein. In use, the child typically places his/her lips around the spout, tilts the cup up and sucks out the liquid volume."

In a further example, page 14 of the specification discloses "the cap has a substantially flat top with a depending collar. The collar has an internal thread adapted to threadedly engage the threaded upper end of the cup. A collar includes an inner flange that extends around the cap concentrically with and inside of the thread. The inner flange forms a recess for receiving a washer-like sealing ring, which ring is adapted to sealingly engage an upper edge of the cup to form a seal between the cap and the cup. The washer-like sealing ring could be eliminated if desired. In addition, the top of the cap may have a generally circular shape, and a spout projects from one side thereof upwardly. The spout is formed integrally with the cap, and includes generally arcuate front and rear walls that converge to an outwardly protruding tip of the spout. In one example, the tip may include one or more spaced-apart openings, the size and area of which are chosen to provide adequate fluid flow to a young user. In another example, a cylindrically shaped or barrel-shaped tubular flange may extend downwardly from the bottom of the spout. In use, the cover is screwed on to the top of the container by cooperant threads." [emphasis added]

Now, in the pending November 14, 2003 Office Action, the Examiner states that “the proposed drawing correction filed 8/14/03 has been disapproved since they enter new matter in the disclosure.” Applicant respectfully requests reconsideration. The following sections of the MPEP concerning “incorporation by reference” state:

MPEP 608.01(P): Material nevertheless may be incorporated by reference, *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966). An application for a patent when filed may incorporate “essential material” by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below. “Essential material” is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode ( 35 U.S.C. 112). In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates “essential material” by reference, or (4) a foreign application. … In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found.

MPEP 2163.07(b): Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text is not new matter. … [emphasis added]

Consequently, there is no new matter added because the drawings 10 and 10A are simply from the patents that are incorporated by reference on page 13 of the original specification – “a valve on the under side of the lid may substantially prevent liquid from leaking out of the spout. Examples of valves that may be used with the present invention include, but are not limited to, the valves disclosed in United States Patent Nos. 5,079,013, 5,542,670, RE37,016, and 6,050,445, which are incorporated by reference herein. In use, the child typically places his/her lips around the spout, tilts the cup up and sucks out the liquid volume.” For example, Fig. 10 of the present application corresponds

to the cap shown in Fig. 1 of U.S. Patent No. 5,542,670 and Fig. 10A of the present application corresponds Fig. 4 of U.S. Patent No. 5,542,670 – one of the patents “incorporated by reference” for the valve and spout. Thus, under MPEP 2163.07(b), “the information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. **Replacing the identified material incorporated by reference with the actual text is not new matter.**”

#### **B. Amendment To The Claims**

The claims were amended to further clarify the gap between the side walls of an inner surface of the outer cup and an outer surface of the inner cup and between the bottom wall of the inner surface of the outer cup and the outer surface of the inner cup. Specifically, the gap is defined as being “a continuous uninterrupted sealed gap” – neither the side walls nor the bottom walls touch. As such, the spatial relationship between the inner and outer cups are maintained without reinforcing elements within the gap. This amendment is fully supported by the original filed specification. For example, Fig. 9A shows a “continuous uninterrupted sealed gap.”

#### **C. Section 112 Rejection**

With respect to the rejection that “it is not clear what physical structure of the container is required to meet the ‘cup insulation test method’,” the claims have been amended to clarify the physical structure. Specifically, the claims have been amended to add the element that “the sealed continuous uninterrupted gap is sufficiently sized so that the cup assembly takes at least about 100 minutes to reach 70°F when tested by the cup insulation test method ...” Thus, “the sealed continuous uninterrupted gap is sufficiently sized” as the “physical structure of the container [that] is required to meet the ‘cup insulation test method’.”

With respect to the rejection that “it is not clear what physical structure of the container is required to meet the drop test,” the claims have been amended to clarify the physical structure. Specifically, the claims have been amended to add the element that

“the inner cup is configured to be receivable within the outer cup so that the cup assembly does not crack or break when tested by the drop test method.”

With respect to the rejection that “it is not clear what size the cup has to be to satisfy the claimed invention of “less than the size of a typical child’s hand, who is about 5 years old, so the child can sufficiently grasp the cup with one hand,” applicant deleted this element from the claims.

#### **D. Section 102/103 Rejection Based On The Noll Patent**

U. S. Patent No. 3,661,288 (the “Noll” patent) discloses and teaches an “insulated nursing bottle.” In column 1, lines 13 – 25 of the Noll patent, Figure 1 describes that “the bottom and walls whereof are constructed to give an air space by spaced apart elements 106 and 108, preferably comprising a non-frangible substance …to maintain the spatial relationship between the respective interior and exterior walls, reinforcing elements are provided …” In addition, Figure 1 clearly shows that the “reinforcing elements” by showing a cut-away. Consequently, the Noll patent discloses and teaches that reinforcing elements are necessary “to maintain the spatial relationship between the respective interior and exterior walls.”

In contrast, the claimed invention expressly recites that the gap is “a continuous uninterrupted sealed gap” – neither the side walls nor the bottom walls touch. As such, the spatial relationship between the inner and outer cups are maintained without reinforcing elements within the gap. Moreover, the claimed invention recites that “the sealed continuous uninterrupted gap is sufficiently sized so that the cup assembly takes at least about 100 minutes to reach 70°F when tested by the cup insulation test method …” And, “the inner cup is configured to be receivable within the outer cup so that the cup assembly does not crack or break when tested by the drop test method” without reinforcing elements.

Therefore, the Noll patent **teaches away** from “a continuous uninterrupted sealed gap” – no reinforcing elements. Moreover, the Noll patent discloses and teaches that reinforcing elements are necessary for spatial relationship. Thus, the Noll patent **teaches away** from “the inner cup is configured to be receivable within the outer cup so that the

cup assembly does not crack or break when tested by the drop test method” with “a continuous uninterrupted sealed gap.

As such, the present claimed invention is both novel and non-obvious over the Noll patent.

**E. Section 103 Rejection Based On Martin In View Of Bachman Patent**

The Examiner relied on U.S. Patent No. 2,895,636 (the “Martin” patent) as the primary reference. The Martin patent discloses and teaches an insulated drinking glasses, cups, mugs and bowls. Each embodiment, which is shown in the Figures, the inner cup is supported, at least partially, by “dependent lugs or flanges” on the outside bottom of the inner cup that is supported by inside bottom of the outer cup. For example, column 2, lines 50 – 64 discusses Figure 6 that shows “bottom walls 33 of the outer shell has spaced arcuate grooves 37 frictionally to receive dependent lugs or flanges 38 on the bottom wall 34 of the inner shell.” *See also* Figures 2, 5, 8, 9, 10 and 16. *See also* column 2, lines 28-31 re. “preferably the outer shell engaging portion 25 is in the form of spaced arcuate lugs or flanges to prevent movement of the shells relative to one another.” *See also* column 4, lines 15 – 27 re. Figure 16 with “bottom wall 125 is formed with an upstanding pointed lug 127 at its center. ... The inner shell 124 has a bottom wall 130 with a depending disc-shaped button 131 at its center with a central recess 132 therein adapted to seat on the pointed lug 127 on the bottom wall of the outer shell for centering the inner shell in the outer shell for maintaining the shells in spaced apart relation.” Thus, the Martin patent discloses and teaches that reinforcing elements are necessary for structural integrity between the inner and outer cups.

In contrast, the claimed invention expressly recites that the gap is “a continuous uninterrupted sealed gap” – neither the side walls nor the bottom walls touch. As such, the spatial relationship between the inner and outer cups are maintained without reinforcing elements within the gap. Moreover, the claimed invention recites that “the sealed continuous uninterrupted gap is sufficiently sized so that the cup assembly takes at least about 100 minutes to reach 70°F when tested by the cup insulation test method ...” And, “the inner cup is configured to be receivable within the outer cup so that the cup

assembly does not crack or break when tested by the drop test method" without reinforcing elements.

Therefore, the Martin patent **teaches away** from "a continuous uninterrupted sealed gap" – no reinforcing elements. Moreover, the Martin patent discloses and teaches that reinforcing elements are necessary for spatial relationship. Thus, the Martin patent **teaches away** from "the inner cup is configured to be receivable within the outer cup so that the cup assembly does not crack or break when tested by the drop test method" with "a continuous uninterrupted sealed gap.

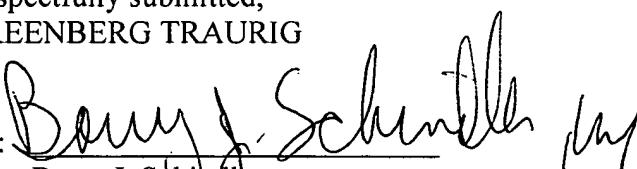
As such, the present claimed invention is both novel and non-obvious over the Martin patent. Since the primary reference, the Martin patent, has been overcome, the secondary references (i.e. Bachman and Kennedy) are not pertinent.

#### **F. Conclusion**

Therefore, it is respectfully submitted that the invention recited by pending claims is neither shown nor suggested by any of the cited documents (either alone or in combination) and that the rejection made in the November 14, 2003 Office Action has been overcome.

Accordingly, it is respectfully submitted that the above-identified application is now in condition for allowance. Favorable reconsideration is earnestly solicited.

Respectfully submitted,  
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